

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JAN. 4, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Ed Tucker Distributor, Inc.**

Serial No. 75/120,143

Kay Lyn Schwartz of Gardere & Wynne for applicant.

Won T. Oh, Trademark Examining Attorney, Law Office 104
(Sidney Moskowitz, Managing Attorney).

Before Hanak, Quinn and Rogers, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Ed Tucker
Distributor, Inc., doing business as Tucker-Rocky
Distributing, to register the mark BIKE IN A BOX for
"rolling chassis for a custom motorcycle sold in a kit of
prepackaged parts."¹

¹ Application Serial No. 75/120,143, filed June 17, 1996,
alleging a bona fide intention to use the mark in commerce.

The Trademark Examining Attorney has refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to applicant's goods, so resembles the previously registered mark BRAKE-IN-A-BOX for "brake structural and replacement parts"² as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

Applicant argues that the marks are different and that the goods sold thereunder are different and travel in distinct trade channels. In addition, applicant contends that the cited mark is weak, that the relevant consumers of applicant's and registrant's goods are sophisticated, and that there has not been any actual confusion between the involved marks. In urging that the refusal be reversed, applicant has submitted a computerized trademark search report and three declarations.

The Examining Attorney maintains that the marks are similar and that the goods, as identified in the registration and application which include no restrictions, are related. In connection with his argument bearing on

² Registration No. 1,003,212, issued January 28, 1975; renewed.

the relatedness of the goods, the Examining Attorney has submitted third-party registrations to show that the types of goods involved herein may be sold by the same party under the same mark.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. We will first turn our attention to these factors, and then will consider the remaining relevant du Pont factors.

With respect to a comparison of the marks BIKE IN A BOX and BRAKE-IN-A-BOX, we find that, when considered in their entirety, the marks are similar in appearance, sound and meaning. The marks are similarly constructed, with each combining the terminology "IN A BOX," which is suggestive in connection with a prepackaged kit of mechanical/structural parts for a vehicle, with the generic term used for the assembly composed of those parts. BIKE IN A BOX is suggestive of a kit of prepackaged parts used to assemble a motorcycle, and BRAKE-IN-A-BOX is similarly

suggestive as applied to registrant's brake parts. Because of the similarities in overall commercial impressions of the marks, if these marks were to be used on related goods, confusion would be likely. In finding that the marks are similar, we have kept in mind the fallibility of human memory over time and the fact that consumers usually retain a general rather than a specific impression of trademarks encountered in the marketplace.

In discussing the differences between the marks, applicant contends that the dominant portions of the marks are the terms "BIKE" and "BRAKE," and that the phrase "IN A BOX" is weak in source-identifying significance and, therefore, that registrant's mark should be accorded only a narrow scope of protection. In connection with this argument, applicant submitted an automated trademark search report (accompanied by the declaration of a legal assistant at the law firm representing applicant) of applications and registrations wherein the marks include the term "BOX," or the phrase "IN A BOX" or "IN THE BOX."

Applicant also highlights the fact that the Office allowed an intent-to-use application for the mark TOP-IN-A-BOX for a retractable convertible car top including power unit, despite the existence of the cited registration. Although that application was subsequently abandoned,

applicant contends that because the Office approved the application for publication, the instant application should also be allowed. Applicant views the publication of that application as an indication that the Office has recognized the weakness of the phrase "IN A BOX," and has acknowledged that purchasers of these mechanical parts look to other components in marks which incorporate the phrase in order to distinguish among such marks.

With respect to applicant's contention that the dominant portions of the marks at issue are the words "BIKE" and "BRAKE," this argument clearly is ill founded. These are generic words for the products identified in the application and registration. As generic terms, they have no source-identifying significance in connection with these products. It is only when they are combined with the suggestive term "IN A BOX" that they can serve as components of these source-identifying marks.

Insofar as the search report is concerned, such evidence generally does not make the registrations/applications listed therein of record. In re Hub Distributing, Inc., 218 USPQ 284 (TTAB 1983). In the present case, however, the Examining Attorney, in the Office action dated May 27, 1998, treated the listed third-party registrations/applications as if properly made of

Ser No. 75/120,143

record. Accordingly, the registrations/applications are considered to be part of the record. In any event, this evidence is of limited probative value in deciding the issue of likelihood of confusion in this case inasmuch as the registrations/applications do not establish that the marks shown therein are in use, much less that consumers are so familiar with them that they are able to distinguish among such marks by focusing on components other than the ones shared by the marks. *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973); and *Red Carpet Corp. v. Johnstown American Enterprises, Inc.*, 7 USPQ2d 1404 (TTAB 1988). Moreover, out of all of the "IN A BOX" marks listed in the search report, only one (TOP-IN-A-BOX) appears to be for goods pertaining to motor vehicles. This fact further diminishes the probative value of this evidence. See, e.g., *Chemical New York Corp. v. Conmar Form Systems, Inc.*, 1 USPQ2d 1139, 1144 (TTAB 1986).

The Office's action with respect to the TOP-IN-A-BOX application likewise is of little moment herein. We have no way of knowing what the basis was for approving that application. Moreover, neither the present Examining Attorney nor the Board is bound by the Examining Attorney's action in connection with that application.

Turning now to a consideration of the goods, we initially point out that both a motorcycle sold in a kit of prepackaged parts, and brake parts are mechanical-type products which could be purchased by the same person. With respect to the similarities between the goods, the Examining Attorney submitted third-party registrations to support his contention that the same entities sell both types of goods involved in this appeal under the same mark. We find that these registrations have probative value to the extent that they suggest that the listed goods (brakes and chassis) are of a type which may emanate from a single source. In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1786 (TTAB 1993).

Applicant contends, however, that its products would move in different trade channels from the goods listed in the cited registration. Of record is the declaration of Frank Esposito, applicant's president and chief operating officer. Mr. Esposito states, in pertinent part, that applicant does not sell its products directly to retail customers, but rather sells to authorized distributors who subsequently sell to retail customers. Also of record is the declaration of a legal assistant at the law firm representing applicant, accompanied by an excerpt from a

web page. The page shows registrant's goods to be characterized as "aftermarket products."

This evidence and applicant's argument based thereon are not persuasive. The issue of likelihood of confusion between marks must be determined on the basis of the goods as they are identified in the respective application and registration, which here are without the restrictions or limitations pointed to by applicant. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); and *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). In the absence of restrictions or limitations in the identifications of goods in the involved application and registration, it is assumed that registrant's brakes could be used in connection with motorcycles, and that the goods move in the same channels of trade to the same classes of purchasers.

In addition, Mr. Esposito claims, in his declaration, that applicant's goods cost approximately \$8000 and are purchased by sophisticated buyers. Although this du Pont factor weighs in applicant's favor, it is outweighed by the other relevant factors considered in our analysis.

Applicant's contention that confusion is not likely because the registered mark is not famous misses the mark. This contention is without any factual support. In any

event, fame need not be established in order to cite a registered mark against the registration of another mark with which it is likely to be confused.

Lastly, applicant asserts that there have not been any instances of actual confusion despite applicant's use and extensive advertising of its mark since January 1996. The statement of no actual confusion is supported by Mr. Esposito's declaration.

The absence of evidence of actual confusion does not compel a different result in this appeal. Although applicant asserts that its advertising has been extensive, no specifics are given. Thus, we are at a great disadvantage in assessing whether there has been a meaningful opportunity for confusion to occur in the marketplace. In any event, the test in deciding this appeal is likelihood of confusion.

To the extent that any of the points raised by applicant or the dissent may cast doubt on our ultimate conclusion on the issue of likelihood of confusion, we resolve that doubt, as we must, in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); and In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Ser No. 75/120,143

Decision: The refusal to register is affirmed.

T. J. Quinn

G. F. Rogers
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

Ser No. 75/120,143